

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MARK S. CHEE
and ROBERT J. LIPSHUTZ
(5,795,716)

and

MARK S. CHEE
(5,974,164),

Junior Parties,

v.

RADOJE T. DRMANAC
and RADOMIR B. CRKVENJAKOV
(09/358,875),

Senior Party.

Patent Interference No. 104,552

NOTICE REDECLARING INTERFERENCE
(37 CFR § 1.611)**Part A. Redeclaration of interference**

This interference is redeclared (35 U.S.C. § 135(a)) with the captioned parties.

Details of the application, patents, count, and claims designated as corresponding or not corresponding to the count appear in Parts E and F of this NOTICE REDECLARING INTERFERENCE.

MAILED

APR 25 2001

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**Part B. Administrative patent judge assigned
to administer the interference**

Richard Torczon will continue to administer this interference. 37 CFR § 1.610.

Part C. Standing order

The STANDING ORDER remains in effect. Chee has **21 days** from the date of this order to comply with §§ 20 and 21 of the STANDING ORDER with regard to the added Chee 164 claims. Chee should also promptly report any other changes (e.g., in the real party-in-interest).

Part D. No conference call to set dates

No conference call will be set. Instead, the parties should proceed to file motions in accordance with Paper No. 29. No review of this redeclaration is available directly, so each party must file a preliminary motion to preserve any challenge to this redeclaration.

Part E. The parties to this interference

Junior Parties

Inventors: MARK S. CHEE and
ROBERT J. LIPSHUTZ, both of Palo Alto, California

Patent: 5,795,716, issued 18 August 1998 (08/327,525, filed 21 October 1994)

Title: Computer-aided visualization and analysis system for sequence evaluation

Priority benefit: None

Inventor: MARK S. CHEE

Patent: 5,974,164, issued 26 October 1999 (08/531,137, filed 16 October 1995)

Title: Computer-aided visualization and analysis system for sequence evaluation

Priority benefit: 08/327,525, filed 21 October 1994 (5,795,716, issued 18 August 1998)

Assignee: Affymetrix, Inc.

Attorneys: See last page

Address: See last page

Senior Party

Inventors: RADOJE T. DRMANAC, of Palo Alto, and
RADOMIR B. CRKVENJAKOV, of Sunnyvale, both of California

Application: 09/358,875, filed 22 July 1999

Title: Computer-aided system for hybridization analysis of nucleic acids

Priority benefit: 09/176,819, filed 22 October 1998 (5,972,619, issued 26 October 1999);
08/820,534, filed 19 March 1997;
08/460,853, filed 5 June 1995 (5,695,940, issued 9 December 1997);
08/203,502, filed 28 February 1994 (5,525,464, issued 11 June 1996);
08/048,152, filed 15 April 1993; and
07/576,559, filed 31 August 1990

Assignee: Hyseq, Inc.

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 2

The count remains as indicated in Paper No. 29 at 2 with the clarification that the "Chee claim" is from Chee's 5,795,716 patent:

The system of Chee 716 claim 5 OR Drmanac claim 14.

The claims of the parties are:

Chee 716: 1-10

Chee 164: 1-27

Drmanac: 1-18

The claims corresponding to Count 1:

Chee 716: 1-10

Chee 164: 1-5, 9, 13-18, 22, 26, and 27

Drmanac: 1-18

The claims not corresponding to Count 1:

Chee 716: None

Chee 164: 6-8, 10-12, 19-21, and 23-25

Drmanac: None

Discussion

The reasons given in Drmanac Miscellaneous Motion 2 (Paper No. 31) are adopted as the basis for the correspondence of the corresponding Chee 164 claims except as noted in this discussion. First, it should be noted that the claims discussed in Drmanac's showing were not identical to the Chee claims the examiner rejected for double-patenting. For instance, Drmanac did not provide a specific reason for the correspondence of Chee 164 claim 26, which the examiner had rejected for double-patenting, but did provide reasons for claims 5, 7, 9, 18, 22, and 20. Since claims 7 and 20 depend from claims (6 and 19) that the examiner did not reject for

double-patenting and for which Drmanac did not provide reasons for corresponding, those claims are not designated as corresponding.

A further note is in order regarding double-patenting. While it is true that "same patentable invention" invention analysis is akin to the double-patenting analysis, the key difference is that the inventors are unrelated (hence the need for an interference). The proper comparison for Drmanac's motion would have been between Drmanac's claims and Chee's 164 claims. Since Drmanac's claims are essentially identical to Chee's 716 claims, no serious error arose from Chee's approach in this motion, but for doctrinal reasons (and for purposes of ultimate review) it is important to make clear why Chee's 164 claims are believed to interfere. On a different set of facts, Chee's approach could lead to serious errors.

Part G. Caption to be used on papers

The caption on the following page shall be used on all papers further papers filed in the interference. See § 18 of the STANDING ORDER.

Interference No. 104,552
Chee v. Drmanac

Paper No. 32
Page 6

Filed on behalf of: Party _____

Paper No. ____¹

By: Name of lead counsel
 Name of backup counsel
 Street address
 City, State, and ZIP Code
 Tel:
 Fax:

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TITLE OF PAPER

¹ Leave blank for the Board to insert the paper number when the paper is entered into the administrative record.

Part H. Summary of dates for taking action

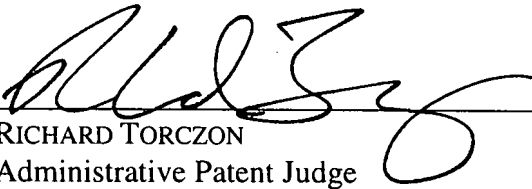
Dates and times for taking action are set in the following sections of the STANDING

ORDER:

1. § 7 - only if a change has occurred.
2. § 8 - only if a change has occurred.
3. § 9 - not applicable.
4. § 17 - not applicable.
5. § 19 - not applicable.
6. § 20 - date for Chee to file clean copy of its 164 claims.
7. § 21 - date for Chee to file clean copy of its 164 claims in cases with drawings or claims containing a means-plus-function limitation.
8. § 23 - times for filing oppositions to Rule 635 motions and times for filing replies to oppositions.
9. § 33 - time for objecting to admissibility of evidence.
10. § 34 - time for serving supplemental affidavits or evidence to respond to an objection to admissibility of evidence.
11. § 35 - times when cross-examination can take place.
12. § 45 - times for taking action with respect to settlement discussions

Part I. [RESERVED]

Part J. Signature and enclosures


RICHARD TORCZON
Administrative Patent Judge

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